

HEWLETT-PACKARD COMPANY
Legal Department, IPA Section, ms: 35
P O BOX 272400
3404 East Harmony Road
Fort Collins, CO 80528-9599

PATENT APPLICATION

Attorney Docket No: 200312175-1
Application No. 10/765,628

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Timothy D. Strecker et al. Examiner: Melvin Cartegena
Application No: 10/765,628 Group Art Unit: 3754
Filing Date: January 27, 2004 Confirmation No: 2262
Title: DISPENSING APPARATUS INCLUDING A CERAMIC BODY

COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

In response to Examiner's Office Communication dated October 10, 2006 Applicants respond as follows:

Examiner has identified seven patentably distinct species:

- Species 1 the embodiment shown in Fig. 1.
- Species 2 the embodiment shown in Figs. 2a-2d.
- Species 3 the embodiment shown in Figs. 3-4.
- Species 4 the embodiment shown in Fig. 5.
- Species 5 the embodiment shown in Figs. 6a-6c.
- Species 6 the embodiment shown in Figs. 7a-7b.
- Species 7 the embodiment shown in Figs. 8a-8b.

Applicants affirm that the above seven species identified by the Examiner are patentably distinct. However, Applicants believe that the restriction requirement is improper and traverse this restriction requirement. Applicants note that MPEP §806.04(f) states that where "two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations

disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species the claims must not overlap in scope." Examiner appears to have arbitrarily picked all the figures and in so doing has not identified the true species associated with this case but has identified various embodiments that read on limitations that are not mutually exclusive. That is Examiner appears to not have seen that the figures do not represent the true species of Applicants invention but rather represent various embodiments that are examples of various subcombinations common to various species. MPEP 806.04(c) clearly states the "scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim. Alternatively, a claim may encompass two or more of the disclosed embodiments (and thus be designated a generic or genus claim). Applicants assert that the figures do not properly represent the true species in this case. For example, the heating elements shown in Figs. 8a and 8b may be utilized in any of the embodiments shown in Figs. 1-7, i.e. embodiments with one or two inlets may utilize any of the heating arrangements shown in Figs. 8a and 8b or any of the embodiments showing 1 or 2 inlets, e.g. Figs. 1-8 may be combined with any embodiment with one or two feed screws, e.g. also Figs. 1-8. Therefore by the definition given above the figures cannot in this particular case be used to identify species that are mutually exclusive and cannot be used to identify which claims read on the figure and properly be specific species claims.

Further, Applicants note that Examiner "[i]n making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other." MPEP 806.04(h). Applicants assume for this response that Examiner is clearly asserting that all of the identified species described in the Office Communication are clearly patentable over each other.

Finally, Examiner has failed to provide an explanation how a seven way restriction is a reasonable number of species since "the examiner may require restriction of the claims to not more than a reasonable number of species . . ." 37 C.F.R. §1.146. Examiner

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has provided no reasoned explanation of why claims to species 1 and 2 or claims to species 5 and 6 cannot be examined together without causing any undue burden.

The present restriction requirement not only improperly shifts the Examiner's burden to the Applicants, but also subjects the Applicants to the added financial burden of prosecuting different claims in an unreasonable number of separate proceedings. Applicants respectfully request that Examiner reconsider the current restriction and withdraw this restriction requirement.

Thus, Applicants hereby provisionally elect with traverse species 7 covering claims 1-4, 12-23, 25-35, 37-44, and 48-59. Applicants assume for purposes of this response that Examiner has made a complete requirement for restriction in accordance with MPEP §§815 and 817. If Examiner has not made a complete requirement then Applicants respectfully request that Examiner withdraw this restriction requirement and provide a complete restriction requirement so that Applicants can properly assess Examiner's assertions. Applicants believe that this reply is complete and represents a *bona fide* attempt to advance prosecution of this application. In addition, Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional, continuation, and/or continuation-in-part applications that cover the non-elected claims.

Applicants note that upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species.

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Information Disclosure Statement

Applicant respectfully requests that a copy of the 1449 Form, listing all references that were submitted with the Information Disclosure Statements filed on January 27, 2004, marked as being considered and initialed by the Examiner, be returned with the next official communication.

Hewlett-Packard Company
1000 NE Circle Blvd. m/s 422B
Corvallis, OR 97330
(541) 715-1694

Respectfully submitted,
Timothy D. Strecker et al.

By: /Donald J. Coulman/
Donald J. Coulman
Reg. No. 50,406
Attorney for Applicant

Date: 8 October 2006